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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

BROWN, RUEBEN M

ART UNIT PAPER NUMBER

2611

DATE MAILED: 11/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/687,149

Applicant(s)

SIE ET AL.

Examiner

Reuben M. Brown

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 11/17/03, 12/22/03, 10/17/02, 11/10/02, 12/15/02, 10/15/01
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-5, 15-16, 18, 21 & 23-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Baker, (U.S. Pat # 5,583,561).

Considering claim 1, the claimed method for distributing programming, comprising:

‘transmitting a first set of programs in real time according to a schedule of programming’, is broad enough to read on the discussion that PPV or VOD programs are transmitted to viewers based upon their schedules, (col. 6, lines 15-38 & col. 13, lines 38-67 thru col. 14, lines 1-30).

‘storing a second set of programs on a server, at least one of the first set of programs having a counterpart in the second set of programs’, (col. 13, lines 55-67), which teaches that multiples copies of a movie may be stored on a server.

‘playing at least one of the second set of programs from the server under the control of the user’, is broad enough to read on (col. 14, lines 21-62), which teaches that when a user presses Pause the current stream or copy of the movie is temporarily stopped. If the user presses

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Play after a certain time has elapsed, then the user is switched to a different stream (i.e., copy) of the movie. This procedure corresponds the user accessing a second set of the program from the server, under the instant user's control.

Considering claim 2, the claimed 'switching from transmission of a particular program according to a schedule of programming to transmission of a counterpart to the particular program from the server is also met by col. 15, lines 1-10 & col. 15, lines 50-60).

Considering claim 3, the claimed 'program control signal from a user', is met by the Stop, Pause, Rewind, Forward and Play commands from the user, col. 15, lines 1-67 thru col. 16, lines 1-9.

Considering claim 4, the claimed feature of 'playing the counterpart from the beginning of the counterpart program' is broad enough to read on the user Rewinding to beginning of the movie, thus the copy of the movie that the user is switched to is from its beginning, (col. 15, lines 1-21 & col. 16, lines 1-9).

Considering claims 5 & 23-24, the claimed method of:

'ascertaining a temporal position for the transmission of the particular program' and 'playing the counterpart to the particular program from substantially the same temporal position', also reads on the discussion of Baker, (col. 14, lines 39-67).

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'whereby the user perceives transmission of the particular program to be substantially interrupted' is also broad enough to read on the disclosure in Baker that upon pressing Play, the user is rejoined to the closest stream that reaches the point of the movie at which the user did interrupt the original stream.

Considering claims 16 & 21, the server in Baker is remote from the user.

Considering claim 18, the claimed method steps for distributing programming, comprises steps that corresponds with subject matter mentioned above in rejection of claim 1 and is likewise rejected.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 6-14 & 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baker, in view of Banker, (U.S. Pat # 5,357,276).

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Considering claims 6 & 19, Baker discusses the viewer accessing VCR-like features using a Touchtone telephone or a computer w/ modem, (col. 7, lines 35-46), but does not discuss using a wireless remote control. However, Banker, which is in the same field of endeavor as Baker, teaches customer accessing VCR-like features in a VOD system using a wireless remote control at the customer site, (Fig. 3; col. 6, lines 22-54 & col. 7, lines 66-67 thru col. 8, lines 1-65 & col. 9, lines 1-13). It would have been obvious for one of ordinary skill in the art at the time the invention was made, to modify Baker to operate using a wireless remote control as taught in Banker, at least for the known desirable benefit of the user friendly graphical user interface disclosed in Banker.

Considering claim 7, the claimed feature reads on the disclosure un Baker that the Video Server SW 60 keeps track of the synchronization of the viewers with the various streams of video programming, (col. 14, lines 21-55).

Considering claims 8 & 11, regarding the claimed feature of, 'transmitting a menu of programs from which the user can select the at least one of the second set of programs from the server played under control of the user', Baker only discusses that depending upon which command the user selects, (such as Rewind, Pause, Forward), the instant user will be placed into a different video stream, when the Play option is selected, but does not explicitly discuss that the user may choose from a menu. However, (Fig. 6A & 6B; col. 10, lines 1-50) Banker discloses providing the subscriber with a list or menu of the second set of programs from which to choose. It would have been obvious for one of ordinary skill in the art at the time the invention was

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made, to modify Baker with the option of providing the customer with a menu of programs to choose from, at least for the desirable improvement of allowing the viewer more direct control over the viewing experience as taught by Banker, see col. 11, lines 52-67 thru col. 12, lines 27.

Considering claims 9-10, 12, & 20 Baker does not discuss any authorization procedure. Nevertheless, Banker discloses a user being authorized to receive programming from the server, (col. 6, lines 59-64; col. 7, lines 58-647 col. 11, lines 1-25). It would have been obvious for one of ordinary skill in the art at the time the invention was made, to modify Baker with the feature of verifying authorization of the customer, for the desirable advantage of ensuring that only the subscribers that actually authorized receive programming for viewing.

Considering claim 13, the claimed feature corresponds with subject matter mentioned above in the rejection of claim 4, and is likewise treated.

Considering claim 14, the claimed feature corresponds with subject matter mentioned above in the rejection of claim 5, and is likewise treated.

5. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Baker, in view of Edwards, (U.S. Pat # 5,604,528).

Considering claim 15, Baker does not discuss detecting is a customer is authorized. Nevertheless, Edwards provides a teaching of system operators providing free previews as an

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incentive for regular CATV users to subscribe to the premium channels, which reads on the claimed feature of transmitting promotional material describing access to programs on the server to users determined not to be authorized to access to programs. It would have been obvious for one of ordinary skill in the art at the time the invention was made, to modify Baker with the feature of providing promotional material to unauthorized viewers for the advantage of providing an incentive to subscribe to the premium service, as taught by Edwards.

6. Claims 17 & 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baker, in view of Garfinkle, (U.S. Pat # 5,530,754).

Considering claims 17 & 22, Baker does not teach using a server local to the subscriber. Nevertheless, Garfinkle teaches using a local server to download at least a portion of a subset of the programs at the main server, (Abstract, col. 3, lines 5-12; col. 4, lines 14-35).. It would have been obvious for one of ordinary skill in the art at the time the invention was made, to modify Baker store at least a portion of video programs at a local user device, at least for the benefit of the subscriber receiving the initial portion faster, as taught by Garfinkle.

### *Conclusion*

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

A) DeMoney Near VOD system.



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**Any response to this action should be mailed to:**

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**Or:**

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*Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive,  
Arlington, VA., Sixth Floor (Receptionist).*


Any inquiry concerning this communication or earlier communications from the  
examiner should be directed to Reuben M. Brown whose telephone number is (703) 305-2399.

The examiner can normally be reached on M-F (8:30-6:00), First Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's  
supervisor, Christopher Grant can be reached on (703) 305-4755. The fax phone numbers for the  
organization where this application or proceeding is assigned is (703) 872-9306 for regular  
communications and After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding  
should be directed to the receptionist whose telephone number is (703) 305-4700.

Reuben M. Brown

  
REUBEN M. BROWN  
PATENT EXAMINER